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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,318	11/26/2001	Robert J. Gallagher	100110474-2	9510

7590

09/06/2005

HEWLETT-PACKARD COMPANY
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EXAMINER

ZEENDER, FLORIAN M

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,318

Applicant(s)

GALLAGHER ET AL.

Examiner

F. Ryan Zeender

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9-11, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/6/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

4A

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Invention I (**claims 1-3**), and species V (claims 1-3, 9-11, & 17-18) in the reply filed on 12/6/2004 is acknowledged.

The applicant has argued in the reply received June 6, 2005 that the Examiner erred in withdrawing claims 9-11 and 17-18 from consideration in the Office action mailed 3/8/2005. However, these claims were drawn to a non-elected invention **in the Restriction requirement**. The "Restriction" requirement and the "Election of Species" requirement are separate and distinct requirements. Since the applicant elected Invention I (claims 1-3) in the Restriction requirement, then all other claims are withdrawn from consideration, regardless of the election of species requirement.

The Restriction and Species requirements are deemed proper (along with the associated withdrawal of claims 9-11 and 17-18 from consideration), and the requirements are FINAL.

Claim Rejections - 35 USC § 103

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong US5335169, in view of Manzi et al. US6298333.

Chong discloses a program controlled apparatus for identifying taxable financial transactions, collecting data based on the transactions, and calculating any taxes due on the transactions, the apparatus comprising: a first module having a directory of all jurisdictions by "tax authority code" (based on customer location; See Col. 4, lines 24-30) requiring payment of taxes; a second module 34 having a directory identifying the

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taxability of goods by each jurisdiction through the use of codes; a third module having a directory of tax rates 33, and a server having programming for determining all taxes due on each transaction (See for example Cols. 3-4).

Chong lacks specifically the use of a first, second, and third “database”; the directory of jurisdictions being specifically by zip code; and the identity of use and rental tax rates.

Manzi et al. teach the identification of use and rental tax rates in a system that automatically determines taxes due.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chong to include tax rates for usage and renting, in view of Manzi, in order to provide a means to improve the “timing” of payment of such taxes to authorities (See Manzi Col. 1, lines 48-50).

It would have been a further obvious design choice to one of ordinary skill in the art to have first, second, and third databases as the use of multiple databases is well known in the art of computer technology in order to provide a desired result.

It would have been further obvious to one of ordinary skill in the art at the time of the invention have the tax authority codes be zip codes as it is well known that zip codes provide a means for determining “location”.

Response to Arguments

Applicant's arguments filed 6/6/2005 have been fully considered but they are not persuasive.

On pages 12-13 of the arguments, applicant states that Chong fails to teach or suggest a first database having a directory of parameters identifying all domestic taxing jurisdictions by zip code, geocode, or jurisdiction name. The tax authority maintenance module 32 identified by Chong in for example Col. 4, lines 25-30, does, at least inherently, identify the taxing jurisdictions by jurisdiction name (i.e., state and city or county; See Col. 4, line 30). The jurisdiction name could be used as the geocode for the purposes of applicant's claim 2. The Examiner has addressed the "zip code" limitation in the rejection above as being obvious in view of Chong's teaching of the identification of tax authorities using customer locations. The rejection is proper as it is well known in the art that zip codes provide a means for identifying customer location.

The applicant then argues that Chong fails to teach or suggest identifying the taxability of goods and/or services through the use of commodity codes. However, Chong teaches the use of, for example, sales type codes (See for example Col. 4, lines 37-40) which would include commodity codes.

The applicant further states that Chong fails to teach or suggest that the tracking system provides programming capabilities. However, Chong does teach programming capabilities (See for example Col. 11, lines 35-40).

The Manzi et al. reference is used to teach that it is well known in the art to identify use and rental tax rates in a system that automatically determines taxes due. The other limitations are taught by Chong, as described above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (571) 272-6790 until April 13, 2005 and (571) 272-6790 thereafter. The examiner can normally be reached Monday-Friday, 8am-5pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The receptionist's phone number for the Technology center is (571) 272-3600.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

F. Zeender
Primary Examiner, A.U. 3627
August 31, 2005

 8/31/05
F. RYAN ZEENDER
PRIMARY EXAMINER